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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,333	12/06/2000	Roger D. Pirkey	10942/269227	1489

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PILLSBURY WITHROP LLP
1600 Tysons Boulevard
Intellectual Property Department
McLean, VA 22102

EXAMINER

PYZOCHA, MICHAEL J

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/732,333	PIRKEY ET AL.	
	Examiner	Art Unit	
	Michael Pyzocha	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,9,11-13,16,17,19-21,24,26-28 and 31-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,9,11-13,16,17,19-21,24,26-28 and 31-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1,2,4-6,9,11-13,16,17,19-21,24,26-28 and 31-42 are pending.
2. Amendment filed 10/18/2004 has been received and considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1,2,4-6,9,11-13,16,17,19-21,24,26-28 and 31-42 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a system wide list (for always allow, always deny, and always require a PIN lists), does not reasonably provide enablement for a list associated with a plurality of subscribers. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The specification lacks any description of how to associate a list to a plurality of users; it only describes a list for the whole system.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, 6, 9, 13, 16-17, 21, 24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenthal et al (US 5737701).

Referring to claims 1 and 16, Rosenthal et al. discloses a method and apparatus for providing access to resources with the use of personal information numbers comprising the steps of receiving a request from a subscriber to access a resource, providing access to the resource if the resource is included in a list associated with the subscriber or in an always allow list associated with a plurality of subscribers; requiring the subscriber to input a personal identification number if the resource is not included in the list associated with the subscriber and providing access to the resource if the subscriber inputs the correct personal identification number in

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Column 5, lines 35-67, Column 6, lines 1-38, 63-67, Column 7, lines 1-9.

As per claims 2 and 17, Rosenthal et al. discloses the claimed limitation wherein comprising the step of adding the resource to the list associated with the subscriber if the subscriber inputs the correct personal identification number in Column 7, lines 10-22.

As per claims 6, 13, 21, and 28, Rosenthal et al. discloses the claimed limitation wherein the resource is a telephone connection to a destination phone number in Column 6, lines 5-9.

As per claims 9 and 24, Rosenthal et al. discloses a method aid apparatus for providing access to resources with the use of personal information numbers comprising the steps of maintaining a list of resources accessed by a user, allowing the user to access resource: included in the list, requiring the user to enter a personal identification number to access a further resource not included in the list and adding the further resource that the user accesses using the personal identification number to the list in Column 7, lines 34-67, Column 8, lines 1-67, Column 9, lines 1-5 see also column 9 lines 40-65 where a "P" will never be removed and therefore always on the list so will never require the PIN.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 11, 19, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenthal et al as applied to claims 1, 9, 16 and 24 above, and further in view of Gaukel et al (US 5200995).

As per claims 4, 11, 19 and 26 Rosenthal et al fails to disclose the use of an always deny list.

However, Gaukel et al teaches the use of an always deny list (see column 4 lines 8-27).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Gaukel et al's always deny list with the resource restricting method of Rosenthal et al.

Motivation to do so would have been to restrict partial numbers (see column 4 lines 8-27).

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9. Claims 5, 12, 20, 27, 33, 36, 39, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenthal et al as applied to claims 1, 9, 16, and 24 above, and further in view of Mijares Jr. et al (US 6330311).

As per claims 5, 12, 20, 27, 33, 36, 39, and 42, Rosenthal et al fails to disclose an always require PIN list for numbers associated with 900 or international calls.

However Mijares Jr. et al teaches such a list (see column 9 lines 10-43).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Mijares Jr. et al's always require PIN list for 900 or international calls in the call restricting method of Rosenthal et al.

Motivation to do so would have been to allow a user to call the blocked 900 or international numbers (see Mijares Jr. et al column 9 lines 37-43).

10. Claims 31, 34, 37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenthal et al; as applied to claims 1, 9, 16, and 24 above, and further in view of Redd Jr. et al (US 5467388).

As per claims 31, 34, 37, and 40, Rosenthal et al fails to disclose the always allow list comprises a phone number associated with emergency services.

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However, Redd Jr. et al teaches an always allow list with emergency services' numbers (see column 6 lines 42-50).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to have Redd Jr. et al's always allow list of emergency services in the always allow list of Rosenthal et al.

Motivation to do so would have been that allowing them without going through the call block system saves time (see Redd Jr. et al column 6 lines 52-58).

11. Claims 32, 35, 38, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Rosenthal et al and Gaukel et al system as applied to claims 4, 11, 19, and 26 above, and further in view of Rudokas et al (US 5420910).

As per claims 32, 35, 38 and 41, the modified Rosenthal et al and Gaukel et al system fails to disclose the always deny list comprises a phone number associated with fraudulent use.

However, Rudokas et al teaches such a list of fraudulent numbers (see column 5 line 59 through column 6 line 14).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Rudokas et al's method of preventing fraudulent numbers from being called in the call restricting service of the modified Rosenthal et al and Gaukel et al system.

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Motivation to do so would have been prevent cloned identification systems from making calls to fraudulent numbers (see Rudokas et al column 5 line 59 through column 6 line 14).

Response to Arguments

Applicant argues Rosenthal fails to disclose: an always allow list as in claims 1, 9, 16 and 24; an always deny list; and an always require PIN list.

Regarding argument on claims 1 and 16 the argued limitation is in the alternative and therefore is not required. Even so if the limitation is taken into consideration as in claims 9 and 24, Rosenthal teaches an always allow list in column 9 lines 40-65 where any number in the list that is marked as "P" (permanent) would never require a PIN to be entered.

Regarding the always deny and always require PIN lists, based on the amendments new rejections have been made and the previous rejections are withdrawn.. Also the newly cited Gaukel et al discloses the use of an always allow list as seen in column 4 lines 28-33.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS**

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ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER